

### REMARKS

Claims 28-56 remain in this application. Claims 1-27 were canceled previously. New Claims 55-56 have been added. Applicant respectfully requests reconsideration and review of the application in view of the following remarks.

The Examiner objected to the title of the invention as not descriptive. Applicant respectfully disagrees, and maintains that the title is sufficiently descriptive of the invention. In the interest of expediting prosecution and removing issues impeding allowance, however, Applicant has further amended the title to provide additional clarification.

The Examiner objected to the disclosure because it contains an embedded hyperlink, and has required Applicant to delete the embedded hyperlink. Applicant respectfully disagrees. The hyperlink described on pages 8 and 9 of the specification is considered part of the Applicant's invention and are included to satisfy the statutory requirement to describe and enable the invention. Applicant does not attempt to use the hyperlink to incorporate material into the application by reference. Applicant notes that MPEP § 608.01 permits an application to include hyperlinks where they are part of the invention and necessary to satisfy the requirements of patentability, as follows:

Where the hyperlinks and/or other forms of browser-executable codes are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. 112, first paragraph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks. The Office will disable these hyperlinks when preparing the text to be loaded onto the USPTO web database.

Accordingly, Applicant requests the Examiner to withdraw this ground of objection.

Before responding to the Examiner's rejections in view of the prior art, a brief description of the present invention is provided. The present invention provides a method and system that efficiently links information on and about an RFID tag to

corresponding information located on a network, such as the Internet. This link is provided for the purpose of supplementing the limited information that is stored in the RFID tag. The linked information may include an almost limitless amount of additional information without any concern for memory storage limitations as it is stored on a location on the Internet, having an enormous amount of storage capacity. Thus, the present invention allows the RFID tag, through the corresponding location on the Internet, to provide additional information (e.g., about a content of a package attached with the RFID tag) that cannot be conventionally stored on the RFID tag, thereby effectively increasing the storage capacity of the RFID tag.

More particularly, the RFID tag includes an embedded address to facilitate communication with a specific location on a network, such as the Internet. The embedded address may comprise a Uniform Resource Locator or other network address. In an embodiment of the invention, an RFID reader that interrogates the RFID tag will obtain the embedded address and access the network, e.g., such as via a wireless network connection, to automatically access the information relating to the RFID tag that is stored on the network. As a result, the operator of the RFID reader can obtain a much greater amount of information concerning the RFID tag or the object to which it is affixed, such as text, graphics, and other information, exceeding the limited storage capacity of the RFID tag.

In another embodiment of the present invention, upon linking of the information between the RFID tag and the corresponding location on the Internet, the present invention allows for updating of network information from the location on the Internet with data stored in the RFID tag. The RFID tag may be located on a package and the data may describe a content of the package. In another embodiment, the present invention allows for updating of network information from the location on the Internet with first information stored in the RFID tag and second information regarding a location where the RFID tag is interrogated. In yet another embodiment, an operator of an RFID reader that interrogates the RFID tag does not have to take any action (e.g., physically

entering current status information) to update the network information located on the Internet. In addition, the present invention allows for the automatic updating of network information regarding the package attached to the RFID tag and a location of where the RFID tag is interrogated.

The Examiner rejected Claims 28-31, 40-45, and 50 under 35 U.S.C. § 103(a) as being unpatentable over Card et al. in view of Werb et al. Claims 32-39, 46-49, and 51-54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Card et al. and Werb et al., and further in view of UPS ("Track by Tracking Number"). These rejections are respectfully traversed.

Card et al. discloses a data communication manager that provides an interface between different types of bar code scanners and a central computer system. The scanners read package tracking numbers and communicate that information via RF link to the data manager. The data manager uses stored disposition data to determine appropriate disposition of the package.

The Examiner acknowledges that Card et al. fails to disclose an RFID tag or the receiving of information stored in the memory of an RFID tag. To make up for this deficiency, the Examiner proposes the combination of Card et al. with Werb et al. Werb et al. discloses an article tracking system that includes RFID tags.

As an initial matter, there is no teaching or suggestion in the references to combine the data communication manager of Card et al. with the RFID tags disclosed by Werb et al. The Examiner has merely selected unrelated prior art references in an attempt to reconstruct Applicant's invention. It is impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. In *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985), the Federal Circuit noted that "[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." Likewise, in *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992), the Federal Circuit admonished against hindsight reconstruction of an invention in the manner reflected by the present rejections.

According to the Federal Circuit:

[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'

*See also In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991) ("As in all determinations under 35 U.S.C. § 103, the decisionmaker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.")

Moreover, even if such a teaching or suggestion for the proposed combination were present, the cited references fail to disclose any claim of the present invention. Card et al. discloses that a tracking number is read by a scanner from the bar code affixed to a package, and the data communication manager verifies the tracking number and communicates that information to the host computer. The data communication manager compares the tracking number to numbers that are on a table (see col. 15, Ins. 48-50). If the tracking number does not appear on the table, then the data communication manager adds the tracking number to the list and notifies the host computer of the added tracking number (see col. 17, Ins. 1-3). Card et al. does not disclose the manner in which the host computer uses the tracking number.

Significantly, the tracking number is *not* an address identifying a location on a computer network--it is merely an identifier for the bar code. When the data communication manager of Card et al. encounters a tracking number it does not recognize, it has no way to access information on a network corresponding to the tracking number. In contrast, in the present invention, when an RFID tag having an embedded address is encountered, the scanner can readily access the file on the

network associated with the RFID tag—even if the data collection system had never previously encountered this RFID tag. Card et al. completely fails to disclose how a computing device could use the tracking number to automatically access information on a network relating to the package. Werb et al. and UPS each fail to make up for this significant deficiency of Card et al.

More specifically, the proposed combination of references fails to suggest or disclose a method for reading an RFID tag that includes, *inter alia*, the steps of “receiving first information stored in a memory of said RFID tag, said first information including an address identifying a location on a computer network corresponding to said RFID tag ... [and] communicating with said location identified by said address,” as defined in Claims 28 and 50. The proposed combination of references further fails to suggest or disclose a computer network system for reading RFID tags that includes, *inter alia*, “an RFID tag ... having a memory containing at least an address identifying a location on a computer network,” as defined in Claim 43. The proposed combination of references further fails to suggest or disclose an RFID tag that includes, *inter alia*, “a memory ... including a data field containing an address identifying a location on a computer network corresponding to said RFID tag,” as defined by Claim 55. The rejections of all claims based on the cited prior art should therefore be withdrawn.

In view of the foregoing, Applicant respectfully submits that Claims 28-56 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. To the extent it would be helpful to placing this application in condition for allowance, the Applicant encourages the Examiner to contact the undersigned counsel and conduct a telephonic interview.

Serial No. 09/515,297  
October 6, 2003  
Page 15

To the extent necessary, Applicant petitions the Commissioner for a three-month extension of time, extending to October 6, 2003, the period for response to the Office Action dated April 4, 2003. Our check in the amount of \$122.00 is enclosed for the later presentation of one independent claim(s) in excess of three (\$86.00), pursuant to 37 C.F.R. § 1.16(b), and for the later presentation of two total claims (\$36.00) in excess of twenty, pursuant to 37 C.F.R. § 1.16(c). Also, a check in the amount of \$1,720.00 is enclosed for the three-month extension of time pursuant (\$950.00) to 37 CFR §1.17(a)(3) and for request for continued examination (RCE) (\$770.00) pursuant to 37 CFR § 1.17(e). The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,

Date: October 6, 2003



Peter C. Hsueh  
Attorney for Applicant  
Registration No. 45,574

**O'MELVENY & MYERS LLP**  
400 South Hope Street  
Los Angeles, CA 90071-2899  
Telephone: (213) 430-6000